

REMARKS

Entry of the foregoing and further and favorable reconsideration of the subject application in light of the foregoing amendment and the following remarks:

Applicant respectfully submits that no new matter has been added.

Claims 1-14 are currently pending.

Restriction Requirement

On page 2 of the May 5, 2008 Office Action, the Examiner issued a Restriction requirement under 35 U.S.C. 121 and has issued a requirement under 35 U.S.C. 121, requiring the Applicant to elect either (Invention I) Claims 1-10, drawn to a plant root and bulb protection device, classified in class 47, subclass 78 or (Invention II) Claims 13 and 14, drawn to a method for protecting plant roots and bulbs, classified in class 47, subclass 76.

The Examiner asserts that Inventions I and II are related as product and process of use. The Examiner has asserted that the restriction is proper because all the inventions are independent or distinct and there would be a "serious search and examination burden if restriction were not required.

In complete response to the restriction requirement, Applicant hereby elects **with traverse** Invention I, claims 1-10, drawn to a plant root and bulb protection device. Applicant traverses the restriction requirement for several reasons. Invention I and Invention II are inseparably related, particularly as the methods of Claims 13 and 14 relate specifically to the device of Claim 1. More fundamentally, the Examiner is reminded of the restriction requirement issued previously in which the Examiner admitted that Claims 1-10 **and** Claims 13 and 14 constituted a single invention. Applicant respectfully submits that there will be no additional

burden to the Examiner to treat the pending claims together. Accordingly, Applicant respectfully urges the Examiner to withdraw the restriction requirement.

35 USC § 112.

On page 5 of the May 5, 2008 Office Action, the Examiner rejected Claims 2-5, 7 and 8 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner objects to “consists of” language with respect to Claims 2-5. The Examiner further objects to “diagonally shaped apertures” in Claim 7, because the Examiner views the example of Figure 2 as “an elongated ellipse shape.”

In complete response, Applicant has herein above amended the claims to obviate the rejections under 35 USC 112, second paragraph and respectfully urges the Examiner to withdraw the rejections, namely of Claims 2-5, 7 and 8.

35 US 103.

On page 6 of the May 5, 2008 Office Action, the Examiner rejected Claims 1-9 as being unpatentable over Bergman (US 5060420 in view of Tesch (US 3655501)), (incorrectly referenced in the Office Action as US 3644501).

The Examiner asserts that Bergman discloses a protection device, which discloses “most of the claimed invention except for the alternating anti-parallel apertures. The Examiner asserts that Tesch teaches that it is “old and well known in the art to provide a plurality of apertures, in which the apertures are in an alternating anti-parallel orientation” directing attention to Figures 14 and 21 of the ‘501 patent.

In response, Applicant notes that the Claims have been amended hereinabove, obviating the rejections. Fundamentally, however, Applicant notes that the protective device of Bergman,

disclosed in the '020 Patent is a burlap bag, unquestionably distinct from the present invention. The "apertures" disclosed by Bergman are without pattern or orientation of any sort, let alone disclosing the specific repetitive pattern of the present invention. The disclosure of Tesch, asserted by the Examiner as rendering the present invention obvious under 35 USC 103 discloses floor covering materials, requiring openings to prevent buckling of the floor covering due to gaseous buildup resulting from water vapor given atmospheric changes in humidity, or from the application of adhesive to the floor covering.

Moreover, the disclosed "slits" of Tesch are not apertures in the sense that when the material is in its native state, there is no opening; the opening appears upon stretching the material either in response to pressure or application to a curve in the application surface. See Column 3, lines 1-20. Indeed the edges of each "slit" of Tesch contact the remainder of the material when in its native planar state (i.e. not stretched or curved), whereas the "apertures" of the present invention are, in fact, holes in the fabric of the material, which are not closed when laid flat. Although the Examiner uses the terms interchangeably, a "slit" as disclosed by Tesch is a long cut in the fabric of the material. This is distinct from the "aperture" of the present invention, which is disclosed in the Application as an opening or gap in the fabric, having a distinctive shape and pattern in the native state of the fabric (i.e. elongated ellipse). The apertures of the present invention are not the slits of Tesch.

While Applicant appreciates the recent developments of the Courts with respect to interpretation of obviousness under 35 USC 103 as delineated under *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), it is unreasonable to expect one of skill in the art (i.e. horticulture) to view developments in floor covering material for prevention of buckling (as in Tesch) as being "obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains.” 35 USC 103 (emphasis added). Applicant respectfully submits that one of ordinary skill in the art (i.e. horticulture) would not be familiar with floor covering as disclosed by Tesch. Moreover, the disclosure of Tesch discloses numerous floor cover material patterns and designs to address floor cover buckling and adhesion problems. Certainly, nothing disclosed in Tesch teaches, or suggests use of the pattern of alternating elongated ellipses in a repetitive pattern as disclosed by the present invention, let alone in combination as disclosed by Applicant.

Accordingly, Applicant respectfully submits that the Examiner has overextended the ruling of KSR to reach beyond what one of ordinary skill in the art would reasonably find obvious. Applicant respectfully urges the Examiner to withdraw the rejections of Claims 1-10 under 35 USC 103 over Bergman in view of Tesch.

CONCLUSION

For the foregoing reasons, Applicant respectfully submits that the application and amended claims are now in proper form for allowance and that the amended claims are patentable over the prior art. Therefore, Applicant respectfully submits that the application is now in condition for allowance, and solicits favorable action on all pending claims, namely Claims 1-10, 13 and 14.

If for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. 706.03(d) and 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further

proceedings. In the event that there are any questions concerning this Amendment, or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,
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